



UNITED STATES DEPARTMENT OF COMMERCE
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T-D

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/868,801	06/21/01	FENN	OC-529

024959 IM22/1016
PPG INDUSTRIES INC
INTELLECTUAL PROPERTY DEPT
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EXAMINER
SERGENT, R

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 10/16/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/868,801

Applicant(s)
Fenn et al.

Examiner
Rabon Sergeant

Art Unit
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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1. Claims 1-9, 11, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 1 and 11, it is unclear what quantity of reactive diluent may be present and yet still satisfies the “substantially no” language.

Within claim 2, the means of representing the ratio is confusing. It is requested that a clearer ratio range be set forth.

Within claim 11, it is unclear what process steps are denoted or encompassed by “causing or allowing”.

Within claim 12, the use of “obtainable” renders the claim indefinite, because one cannot determine which compositions are “obtainable by” applicants’ process and which are not.

2. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants have failed to specify the type (i.e., number average or weight average) of the molecular weight or how it was determined.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/30099 or NL 9201868.

The references disclose the production of coatings, wherein diphenylmethane diisocyanate is reacted with a polyester corresponding to the instantly claimed polyester. See entire documents. The examiner has considered applicants' "substantially no reactive diluent" language; however, it is unclear what quantity is excluded by the claims, and WO 97/30099 provides for

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diluents having amine groups which are considered to be outside the instantly claimed species of the diluent.

5. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Chattha ('906) or Peng et al. ('508).

Patentees disclose coating compositions derived from the reaction of a polyisocyanate, such as diphenylmethane diisocyanate, with a polyester containing secondary hydroxyl groups, derived from the reaction of carboxyl group containing polyesters with epoxides. See abstract and columns 2-5 within Chattha and abstract and columns 2-7 within Peng et al.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chattha ('906) or Peng et al. ('508), each in view of WO 96/20968 or WO 97/30099.

As aforementioned within paragraph 5, Chattha and Peng et al. disclose coating compositions derived from polyisocyanates and secondary hydroxyl group containing polyesters.

7. Though Chattha and Peng et al. are silent regarding the use of glycidyl esters of $C_8 - C_9$ tertiary carboxylic acids as the epoxide, this epoxide was known at the time of invention to be useful for producing secondary hydroxyl group containing polyesters. See page 7, line 20 within WO 96/20968 and page 6, lines 35-37 within WO 97/30099.

8. Therefore, the position is taken that it would have been obvious to utilize the claimed epoxide within the primary references, so as to arrive at the instant invention, because it has been held that it is obvious to utilize a component for its known function. In re Linder, 173 USPQ 356. In re Dial et al., 140 USPQ 244.

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9. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/20968.

The reference discloses the production of coatings, wherein polyisocyanates are reacted with secondary hydroxyl group containing polyesters which correspond to the polyester of the instant claims. See entire document. Diphenylmethane diisocyanate is disclosed within Peng et al. at column 6, line 54; the isocyanates of Peng et al. have been incorporated within WO 96/20968.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent/om
September 26, 2001


RABON SERGENT
PRIMARY EXAMINER